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In re Application of
TEITELBAUM *et al*
U.S. Application No.: 10/534,055
PCT No.: PCT/US03/09285
Int. Filing Date: 25 March 2003
Priority Date: None
Docket No.: 64118.000192
For: TRANSPEDICULAR
INTERVERTEBRAL DISK ACCESS
METHODS AND DEVICES

DECISION

This is a decision on applicants' "Petition to Withdraw the Holding of Abandonment" filed 10 August 2007.

BACKGROUND

On 09 May 2006, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed. Applicants were given two months to respond.

On 06 June 2006, a renewed petition under 37 CFR 1.47(a) was filed.

On 01 August 2006, a decision dismissing applicants' renewed petition under 37 CFR 1.47(a) was mailed. Applicants were given two months to respond with extensions of time available under 37 CFR 1.136(a).

On 07 August 2006, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed for failing to respond to the 09 May 2006 decision.

On 18 August 2006, applicants submitted a petition to revive the above-captioned application.

On 14 September 2006, a decision was mailed vacating the Form PCT/DO/EO/909. The Form PCT/DO/EO/909 was sent in error as a response to the 09 May 2006 decision was timely filed. On 22 September 2006, another communication was mailed indicating that the Form PCT/DO/EO/909 mailed 07 August 2006 was vacated.

On 11 October 2006, applicants purportedly filed a reply to the 01 August 2006

decision via facsimile which was accompanied by, *inter alia*, a declaration signed by the nonsigning inventor, Frank Nguyen. However, these papers were not located in the above-captioned application.

On 31 May 2007, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed for failing to respond to the 01 August 2006 decision.

On 10 August 2007, applicants filed the subject petition to withdraw the holding of abandonment which was accompanied by, *inter alia*, copies of the documents purportedly filed via facsimile on 11 October 2006 and a copy of an "Auto-Reply Facsimile Transmission" dated 11 October 2006.

DISCUSSION

Petition to Withdraw the Holding of Abandonment

Applicants claim that a response to the decision mailed 01 August 2006 was filed via facsimile on 11 October 2006. This response included a declaration signed by the missing inventor and authorization to charge \$250.00 in fees to counsel's Deposit Account.

USPTO financial records for the subject application show that the surcharge fee and one-month extension fee were received on 11 October 2006. However, the signed declaration and other papers filed 11 October 2006 were not located in the file.

37 CFR 1.8 *Certificate of mailing or transmission*, states in part:

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

- (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or

transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement . . .

In the subject petition, applicants have provided a copy of the documents purportedly filed 11 October 2006. Applicants included an "Auto-Reply Facsimile Transmission" from the USPTO. A review of the evidence shows that the USPTO received a facsimile on 11 October 2006 consisting of 7 pages. The cover page of the facsimile lists the proper U.S. application number, title and name of applicants. The document certifies that a "Third Petition Under 37 CFR 1.47(a)" were among the papers received. The statements in the petition and documentary evidence are sufficient to satisfy item (3) of 37 CFR 1.8(b).

This evidence is sufficient for a grantable petition.

Renewed Petition Under 37 CFR 1.47(a)

As a response to the decision mailed 01 August 2006, applicants submitted a declaration signed by the missing inventor, Frank Nguyen, on 11 October 2006.

The declaration submitted is in compliance with 37 CFR 1.497(a) and (b). No further action on the petition under 37 CFR 1.47(a) is required.

CONCLUSION

Applicants' petition to withdraw the holding of abandonment under 37 CFR 1.8(b) is **GRANTED**. The Form PCT/DO/EO/909 mailed 31 May 2007 is **VACATED**.

Applicants renewed petition under 37 CFR 1.47(a) is **MOOT**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 25 March 2003, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 11 October 2006. This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.



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